REMARKS

Claims 1, 4, 17, 22-23, 33, 35 and 38 have been amended. Claims 10-16 and 36-37 have been canceled without prejudice, and Applicants reserve the right to re-present the canceled claims and similar claims in a continuation application. Claims 39-40 have been added. The Examiner has withdrawn from consideration Claims 17-25 and 33-38 as being drawn to a non-elected invention. As discussed below, Applicants traverse the restriction requirement, and, thus, Claims 1-9, 17-35 and 38-40 are currently pending in the application.

Claims 1 and 4-5 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-9 and 26-32 stand rejected under the cited prior art. Specifically, the Examiner rejected Claims 1-9 and 26-32 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,088,686 ("Walker"). Reconsideration of the rejections is respectfully requested.

Restriction Requirement

The Examiner contends that the present application includes claims directed to multiple inventions and has required restriction to one of the following inventions under 35 U.S.C. § 121:

I. Claims 1-9 and 26-32, drawn to a method and computer-readable medium for automatically evaluating a financial account applicant for a financial institution;

II. Claims 17-25, drawn to a system for automatically evaluating a financial account applicant;

III. Claim 33, drawn to a computer-implemented method for automatically evaluating a financial account applicant for a financial institution;

IV. Claims 34-35 and 38, drawn to a computer-implemented method for automatically evaluating a financial account applicant for a financial institution including a new financial applicant with no existing financial account with the financial institution; and

V. Claims 36-37, drawn to a computer-implemented method of offering a product to a financial account applicant.

Applicants' Representative made a provisional election, with traverse, of Invention I, Claims 1-9 and 26-32 on October 14, 2003. Applicants respectfully traverse and request reconsideration of the restriction requirement in view of the following. If the restriction requirement is upheld, Applicants affirm the election of Invention I, Claims 1-9 and 26-32.

Two criteria must be met for a proper restriction requirement: (1) the inventions must be patentably independent and distinct as claimed, and (2) there must be a serious burden on

the Examiner if restriction is not required. If the search and examination can be completed without a serious burden, the Examiner must evaluate the merits regardless of whether or not two or more independent or distinct subjects are disclosed.

Applicants respectfully submit that a serious burden is not placed on the Examiner in searching and examining the claims of Invention I-V together. The claims of Invention I-V include limitations generally directed to automatically evaluating a financial account applicant. Specifically, the claims of Invention I-V include limitations relating to one of accessing, evaluating, or retrieving credit bureau data for the applicant; relating to one of accessing, providing, or retrieving account information for the applicant; and relating to generating a score for the applicant based on the credit bureau data and the account information.

In addition, based on the review set forth above of subject matter recited in each of the Invention I-V identified by the Examiner, the system used to perform the computer-implemented method of Invention II and the method for automatically evaluating a financial account applicant of Inventions I and III-V are so inextricably related to one another that the inventions should be examined in a single application. Applicants respectfully contend that a complete and thorough search of the prior art for the system used to perform the computer-implemented method of Invention II or the method of automatically evaluating a financial account applicant of Inventions I and III-V would require a search of the subject matter of the other. In fact, the Examiner has classified all of the inventions to be in class 705, subclass 36.

Thus, a single search and examination directed toward a method of automatically evaluating a financial account applicant will adequately determine the patentability of the amended claims in Groups I-V. Accordingly, Groups I-V should be examined in the same application, and Applicants respectfully request reconsideration of the restriction requirement.

Claim Rejections – 35 U.S.C. § 101

The Examiner indicates that Claims 1 and 4-5 of the invention are directed to non-statutory subject matter. The Examiner contends that Claim 1 is drawn to a method of automatically evaluating a financial account applicant for a financial institution that is not tied to any technological art. The Examiner also contends that Claims 4-5 are not tied to any technological art and that Claims 1 and 4-5 of the invention are directed merely to a human making mental computations and manually plotting results on paper, and thus are nothing

more than an abstract idea, which is not tied to any technological art, and is not a useful art as contemplated by the Constitution. See Office action, mailed October 21, 2003, page 8.

Applicants respectfully disagree but, to further prosecution, have amended Claims 1 and 4-5 to address this rejection. Accordingly, Applicants respectfully request reconsideration of the rejection of Claims 1 and 4-5 under 35 U.S.C. § 101.

Claim Rejections – 35 U.S.C. § 103

The Examiner rejected Claims 1-9 and 26-36 under 35 U.S.C. §103 as being unpatentable over Walker. Reconsideration of the rejections is respectfully requested.

To establish a *prima facie* case of obviousness under Section 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. Moreover, it is improper to combine references where the references teach away from their combination. Applicants respectfully submit that the proposed combination of references does not meet the above criteria with respect to the subject matter of the claims.

Independent Claim 1 defines a computer-implemented method of automatically evaluating a financial account applicant for a financial institution. The method is defined as comprising the acts of accessing credit bureau data for the applicant, accessing account information for the applicant, generating a score for the applicant based on the credit bureau data and the account information, and determining whether to open the financial account based on the score.

Walker discloses a system and method for on-line processing of credit applications. The system includes a financial network terminal 14, a front-end processing and communications system 16, and an ACAPS processing system 26, which accesses various databases. Col. 12, lines 36-48; FIGS. 1A-1B. A local branch representative ("LBR") 12 enters applicant data and the requested credit product. Col. 13, lines 5-12. The entered data is transferred to the ACAPS system 26 for on-line review and approval decision processing. Col. 13, lines 13-18.

The ACAPS system 26 accesses existing customer information stored in databases 18, 20, and 22 to determine a relationship code, which is used to identify price offers for the credit products. Col. 13, lines 19-47. The ACAPS system 26 proceeds to perform a front-end pre-screening process to identify any credit-qualified offers that the LBR 12 can present to the customer 10. Col. 13, lines 48-67. If the customer 10 accepts any of the offers, the credit qualified offer is converted to a request for credit, which requires on-line credit processing for final decision. Col. 14, lines 1-4. The ACAPS system 26 performs a fraud verification, and, if the applicant data passes, the ACAPS system 26 gathers credit bureau reports. Col. 14, lines 17-27. The ACAPS system 26 performs a disaster/policy screening, and, if the applicant data passes, a disaster response code (e.g., A, B, C, or D) is assigned to the application. Col. 14, lines 28-36; col. 7, lines 30-50; FIG. 41.

The ACAPS system 26 continues to process the application by performing a debt burden verification, and, if the applicant data passes, a debt burden response code is assigned to the application. Col. 14, lines 37-46; col. 7, lines 30-50; FIG. 41. The ACAPS system 26 selects the worst response code between the disaster response code and the debt burden response code, which becomes the credit decision subcode. Col. 14, lines 47-49; col. 7, lines 30-50. The credit decision subcode or scoring response code is used to determine where the scoring response code falls within certain predetermined turndown cutoff ranges (e.g., Hard Approval, Investigate Reject-1, Investigate Reject-2, or Hard Reject-3) in order to assign a status code (e.g., RA-recommend approval, CA-conditional approval, CO-counter-offer approval, or RT-recommend turndown) to the application. Col. 14, lines 47-col. 15, lines 21; FIG. 9. The status code determines whether to accept or reject the application or whether to provide a conditional approval of the application. Id.

If the applicant requests a bankcard, the ACAPS system 26 performs additional processing. Col. 15, lines 22-25. The applicant data and requested product information is transferred to the bankcard account fulfillment system ("AFS") 40. If the applicant data passes the AFS 40 requirements, the requested product is assigned a credit limit based on either the application credit score and applicant income or the applicant's bank relationship amount and income. Col. 15, lines 39-43. The AFS 40 performs a maximum debt burden offer if the assigned credit limit is within a certain range to calculate a credit limit. Col. 15, lines 45-60; col. 7, lines 58-66; col. 8, lines 5-10. If the applicant 10 is not a student, a non-resident alien or self-employed, the AFS 40 assigns a bank liability balance response code (e.g., A, B, C, or D) to the application. Col. 15, line 61-col. 16, line 15; col. 7, lines 30-50).

The ACAPS 26 selects the better of the liability balance response code and the credit response code as the final response code. Col. 16, lines 15-18; col. 7 lines 30-50. Based on the final response code, the automated review of the applicant data, and the scoring response code, the ACAPS 26 presents an automated credit offer decision. Col. 16, lines 19-21.

Walker does not teach or suggest, among other things, a computer-implemented method of automatically evaluating a financial account applicant for a financial institution including the act of generating a score for the applicant based on the credit bureau data and the account information. Rather, Walker discloses a system that assigns a first alpha response code to disaster screening data and a second response code to debt burden data. The system of Walker selects the worst response code to be the credit decision subcode. The system of Walker assigns a third alpha response code to bank liability data, and the system selects the better of the credit decision subcode and the bank liability response code as the final alpha response code. The system of Walker merely assigns independent response codes to specific data and selects the best or worst response code to be the combined response code (as in the credit decision subcode and the final response code). In other words, in the system of Walker, the specific data is considered independently of other data when assigning the response codes – the data is not combined prior to assigning a response code. Walker does not teach or suggest generating a score for credit bureau data and applicant account information. Again, the system of Walker merely assigns independent response codes to specific data and selects the best or worst response code to be the combined response code.

The Examiner acknowledges that Walker does not explicitly teach the step of generating a score for the applicant based on the credit bureau data and the account information. See Office action, mailed October 21, 2003, paragraph 7. However, the Examiner takes Official Notice that the step of generating a score for the applicant based on credit bureau data is old and well known in the art. Id. The Examiner contends that this step enables each financial institution to develop their own scoring model based on weighting of factors they deem important. Id. Further, the Examiner contends that this step also helps them [the financial institution] offer products to their customer based on their credit score. Id.

If Official Notice is taken, the basis for such reasoning must be set forth explicitly. M.P.E.P. § 2144.03. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. Id. The Applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the

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assertion in the next reply after the Office action in which the common knowledge statement was made. Id.

Applicants respectfully disagree that the act of generating a score for the applicant based on the credit bureau data and the account information is old and well known in the art. Applicants respectfully traverse the Examiner's reasons for taking Official Notice. In general, financial institutions can obtain, access, and use different data for different purposes. A score may be generated or calculated in a numerous different ways, and each score may have a different meaning for each financial institution. In the present application, the score that is generated is not a credit score, as that term is used in the art. In the art, a credit score is generally pre-calculated by a credit bureau, and that score can differ depending on the credit bureau accessed. Applicants respectfully request that the Examiner present a reference that discloses generating a score based on credit bureau data and account information data. Absent such a reference, Applicants respectfully submit that the act of generating a score for the applicant based on the credit bureau data and the account information is not old and well known in the art.

For these and other reasons, Walker does not teach or suggest the subject matter defined by independent Claim 1. Accordingly, independent Claim 1 is allowable. Dependent Claims 2-8 and new dependent Claim 40 depend from independent Claim 1 and are allowable for the same and other reasons. In addition, the additional subject matter defined by the dependent claims, such as, for example, Claim 40, provides separate bases for allowance.

New dependent Claim 40 further specifies that the score is a numerical score. Walker discloses a system that assigns alpha response codes to certain data. The system of Walker does not teach or suggest generating a numerical score. For these and other reasons, Walker does not teach or suggest the additional subject matter defined by Claim 40.

Independent Claim 9 defines a computer-readable medium storing computer-readable instructions for evaluating a financial account applicant, the instructions directing the computer to perform the acts of accessing credit bureau data for the applicant, accessing account information for the applicant, generating a score for the applicant based on the credit bureau data and the account information, and determining whether to open the financial account based on the score.

Walker does not teach or suggest, among other things, a computer-readable medium that stores computer-readable instructions that performs the act of generating a score for the applicant based on the credit bureau data and the account information. Rather, Walker discloses a system that assigns a first alpha response code to disaster screening data and a

second response code to debt burden data. The system of Walker selects the worst response code to be the credit decision subcode. The system of Walker assigns a third alpha response code to bank liability data, and the system selects the better of the credit decision subcode and the bank liability response code as the final alpha response code. The system of Walker merely assigns independent response codes to specific data and selects the best or worst response code to be the combined response code (as in the credit decision subcode and the final response code). In other words, in the system of Walker, the specific data is considered independently of other data when assigning the response codes – the data is not combined prior to assigning a response code. Walker does not teach or suggest generating a score for credit bureau data and applicant account information. Again, the system of Walker merely assigns independent response codes to specific data and selects the best or worst response code to be the combined response code.

The Examiner acknowledges that Walker does not explicitly teach the step of generating a score for the applicant based on the credit bureau data and the account information. See Office action, mailed October 21, 2003, paragraph 7. However, the Examiner takes Official Notice that the step of generating a score for the applicant based on credit bureau data is old and well known in the art. Id. The Examiner contends that this step enables each financial institution to develop their own scoring model based on weighting of factors they deem important. Id. Further, the Examiner contends that this step also helps them [the financial institution] offer products to their customer based on their credit score. Id.

Again, Applicants respectfully disagree that the act of generating a score for the applicant based on the credit bureau data and the account information is old and well known in the art, and Applicants respectfully traverse the Examiner's reasons for taking Official Notice. Rather than re-present the arguments set forth above with respect to this contention, for brevity's sake, Applicants refer to the discussion above for Claim 1. With respect to Claim 9, the same arguments apply.

For these and other reasons, Walker does not teach or suggest the subject matter defined by independent Claim 9. Accordingly, independent Claim 9 is allowable. Dependent Claims 26-32 depend from independent Claim 9 and are allowable for the same and other reasons.

Claims 17-25 and 33-38 were withdrawn from consideration in the present Office action due to the Examiner's restriction requirement and, thus, have not been substantively examined. Again, Applicants canceled Claims 36-37 without prejudice. With respect to

Claims 17-25, 33-35 and 38, if Applicants are successful in traversing the restriction requirement, Applicants respectfully submit that the prior art of record does not teach or suggest the subject matter defined by Claims 17-25, 33-35 and 38 and that these claims are allowable.

New independent Claim 39 defines a computer-implemented method of evaluating a risk of opening a financial account for an applicant. The method is defined as comprising the acts of establishing policy rules and acceptance criteria for financial account applications and storing the rules and criteria, acquiring credit-related information for the applicant, acquiring debit-related information for the applicant, generating a first score based on the credit-related information, generating a second score based on the debit-related information, generating a third score based on the credit-related information and the debit-related information, comparing the first, second, and third scores to the policy rules and acceptance criteria, and determining whether to accept or reject the application based on the comparison.

Walker does not teach or suggest, among other things, a computer-implemented method of evaluating a risk of opening a financial account for an applicant including the act of generating a first score based on the credit-related information, generating a second score based on the debit-related information, and generating a third score based on the credit-related information and the debit-related information. Rather, Walker discloses a system that assigns a first alpha response code to disaster screening data and a second response code to debt burden data. The system of Walker selects the worst response code to be the credit decision subcode. The system of Walker assigns a third alpha response code to bank liability data, and the system selects the better of the credit decision subcode and the bank liability response code as the final alpha response code.
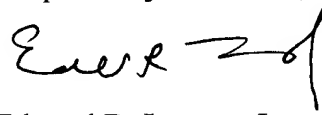
For these and other reasons, Walker does not teach or suggest the subject matter defined by new independent Claim 39. Accordingly, independent Claim 39 is allowable.

CONCLUSION

In view of the foregoing, entry of the present Amendment and allowance of Claims 1-9, 17-35 and 38-40 are respectfully requested.

The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

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